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EXAMINER
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NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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PTOL-90A (Rev. 04/07)

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 February 2009*.
2a)☐ This action is **FINAL.**   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-11 and 20-54* is/are pending in the application.
    4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-11 and 20-54* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____.
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1.   A request for continued examination under 37 CFR 1.114, including the fee set forth in

37 CFR 1.17(e), was filed in this application after final rejection. Since this application is

eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e)

has been timely paid, the finality of the previous Office action has been withdrawn pursuant to

37 CFR 1.114. Applicant's submission filed on 24 February 2009 has been entered.

2.   This communication is in response to the Request for Continued Examination filed on 24

February 2009 and the amendment filed on 2 February 2009. Claims 1, 50-52 have been

amended. Claims 53-54 have been newly added. Claims 12-19 have been previously cancelled.

Claims 1-11, 20-54 are currently pending.

Claim Rejections - 35 USC § 101

3.   35 U.S.C. § 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

4.   Claims 1-10, 20-29, 50, 53-54 are rejected under 35 U.S.C. §101.

        A)   As per claims 1-10, 20-29, 50, 53-54, these appear to be directed toward a method

or process of generating a customized proposal for a customer. Based on Supreme Court

precedent, and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101

process must (1) be tied to another statutory class (such as a particular apparatus) or (2)

transform underlying subject matter (such as an article or materials) to a different state or thing.

Diamond v. Diehr, 450 U.S. 175, 184 (1981); *Parker v. Flook,* 437 U.S. 584, 588 n.9 (1978);

Gottschalk v. Benson, 409 U.S. 63, 70 (1972); *Cochrane v. Deener,* 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a

claim that recited purely mental steps. Thus, to qualify as a § 101 statutory process, the claim

should positively recite the other statutory class (the thing or product) to which it is tied, for

example by identifying the apparatus that accomplishes the method steps, or positively recite the

subject matter that is being transformed, for example by identifying the material that is being

changed to a different state.

In the instant application, Appellant's method steps fail the first prong of the new Federal

Circuit decision since they are not required to be tied to another statutory class and can be

performed without the use of a particular apparatus.   In particular, Applicant's claims do not

recite <u>who or what</u> is performing the method steps. Furthermore, the method steps fail to

unambiguously require transformation of underlying subject matter to a different state or thing.

The mere manipulation and production of non-functional descriptive material (i.e., a "customized

proposal") is not a transformation because a proposal is not statutory subject matter. Thus,

claims 1-10, 20-29, 50, 53-54 are non-statutory since they are not requisitely tied to another

statutory class and they do not requisitely transform underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112

5.   The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6.   Claims 1-10, 20-29, 50-54 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(A)   Newly amended claims 1, 50, 51, and 52 recite limitations that are new matter, and are therefore rejected. The added material which is not supported by the original disclosure is as follows:

* including an indication that a particular insurance plan "had previously been unavailable … [...] ... ," as disclosed in claims 1, 50, 51, and 52 at lines 16, 18, 20, and 22, respectively.

35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. "New matter" constitutes any material which meets the following criteria:

a) It is added to the disclosure (either the specification, the claims, or the drawings) after the filing date of the application, and

b) It contains new information which is neither included nor implied in the original version of the disclosure. This includes the addition of physical properties, new uses, etc.

In particular, the Examiner was unable able to find any support for this newly added language within the specification as originally filed on 20 December 2000. Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

(B)   Claims 2-10, 20-29, 53-54 incorporate the features of claim 1, through dependency, and are also rejected. See *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter. 1990).

Applicant is required to cancel the new matter in the reply to this Office Action.

7.   If Applicant continues to prosecute the application, revision of the specification and claims to present the application in proper form is required. <u>While an application can, be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed on 20 December 2000</u>.

8.   The rejection of claims 1, 50-52 under 35 U.S.C. 112, second paragraph, for being indefinite, is hereby withdrawn due to the amendment filed 2 February 2009.

Claim Rejections - 35 USC § 103

9.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

NOTE: The following rejections assume that the subject matter added in the 24 February

2009 amendment are NOT new matter, and are provided hereinbelow for Applicant's

consideration, in the event that Applicant were to properly traverse the above new matter

objections and rejections made in sections 5-7 above in the next communication sent in response

to the present Office Action.

10.   Claims 1-11, 20-54, are rejected under 35 U.S.C. 103(a) as being unpatentable over

Lockwood, U.S. Patent Number 4, 567, 359 in view of Warady, U.S. Patent Number 6,067,522

and Tyler, U.S. Patent Number 5,523,942, for substantially the same reasons given in the prior

Office Action (paper number 20080709). Further reasons appear hereinbelow.

(A)   As per claim 1, Lockwood teaches a method for generating a customized proposal

in the development of insurance plans for a customer (Lockwood; column 3, lines 32-44,

column 6, lines 3-11), the method comprising steps of:

storing customer data within a database in a computer system (Lockwood; Abstract,

column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line

32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using

one or more modules (Lockwood; Abstract, column 2, lines 48-55); (Examiner interprets

Lockwood's teachings of "programmed to gather a predetermined sequence of information from

a customer on the services in which the customer is interested … [...] … transmit the information

to the central data processing center … [...] … extracts the desired information from its storage

… [...] … transmits it back to the terminal … [...] … relayed to the customer" (Lockwood;

column 2, lines 48-55) to teach a form of using one or more software modules), the database

having stored therein insurance plan products with plan requirements data (Lockwood; column 5,

lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program

information and information on insurance policies and prices for various insurance companies,

which are periodically up-dated from the terminals 4 of the various companies, and information

on policy quotes and sales, which can be accessed periodically by the respective insurance

company terminals ... [   ] ... to perform insurance quotation calculations in response to customer

information received from any of the terminals, to send quotation data to the respective terminal"

(Lockwood; column 5, lines 37-48) to necessarily include storing in the "memory" (reads on

"database") plan requirements data in order to produce the insurance quotation;

　　　　presenting a description of insurance plan options currently available to the customer on a

"terminal" (reads on "display device of the computer system") (Lockwood; column 3, lines 9-48,

column 6, lines 5-11) based upon the stored customer data and the user selected plan options by

using the one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner

interprets Lockwood's teachings of "programmed to gather a predetermined sequence of

information from a customer on the services in which the customer is interested … […] …

transmit the information to the central data processing center … […] … extracts the desired

information from its storage … […] … transmits it back to the terminal … […] … relayed to the

customer" (Lockwood; column 2, lines 48-55) to teach a form of "presenting a description of

insurance plan options currently available to the customer … […] … by using the one or more

modules");

generating a customized proposal in the computer system based upon a selection made

from the presented insurance plan options that includes a description of an insurance plan

(Lockwood; column 3, lines 9-48, column 6, lines 17-32) by using the one or more modules

(Lockwood; column 2, lines 48-55), at least a portion of the customer data, and estimated costs

for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column

2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24,

column 7, line 60 to column 8, line 2, column 9, lines 13-30).

Although Lockwood teaches using one or more modules (Lockwood; column 2, lines 48-

55), and "automatically generat[ing] and issue insurance binder agreements according to

customer's choice and specifications" (Lockwood; column 1, lines 30-35) and automatically

"dispensing information, goods and services such as insurance quotations and policy binders

agreements" (Lockwood; column 1, lines 27-30), Lockwood fails to explicitly disclose

determining if a particular insurance plan may be offered but is not currently available to

the customer based upon the stored plan requirements data and either the stored customer data or

user selected plan options by using the one or more modules, the user selected plan options being obtained from an input device of the computer system; and

the description of insurance plan options including an indication that a particular insurance plan had previously been unavailable to the customer.

However, the above features are well-known in the art, as evidenced by Warady.

In particular, Warady teaches

determining if a particular insurance plan may be offered but is not currently available to the customer based upon the stored plan requirements data and either the stored customer data or user selected plan options by using the one or more modules (Warady; Figure 1, column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7, column 8, lines 20-35, column 9, line 58 to column 10, line 8) the user selected plan options being obtained from an input device of the computer system (Warady; column 13, lines 50-53); and

the description of insurance plan options including an indication that a particular insurance plan had previously been unavailable to the customer (Warady; column 4, line 51 to column 5, line 30, column 5, line 55 to column 6, line 11, column 9, line 58 to column 10, line 8); Examiner interprets Warady's teachings of

> "tables of information that describe the employer ... [...] ... , the employer's health and welfare benefit policies, the <u>benefit plans</u> in which the employer's employees can be enrolled ... [...] ... information can include, for example, the benefit types and coverage options available to the employees for enrollment selection, identification of which benefits are employee selectable and which are attached to other employee selections [reads on "indication that a particular insurance plan had previously been unavailable to the customer" as it is tied to <u>other</u> employee selections]... [...] ... , identification of

[particular] plan features that generate cost or premium billings based on other employee selections but are <u>not</u> benefits disclosed to or payable to employees (e.g., stop loss insurance which protects the employer against excessive claims under self-insured plans) … […] …   It should be appreciated that additional or different information can be included in the benefit files as needed to accommodate different types of benefit plans or employer policies," (emphasis added) (Warady; column 4, line 51 to column 5, line 5);

and Warady's teachings of

" … […] … prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before [i.e. not currently available] the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider … […] … " (Warady; column 5, line 65 to column 6, line 7),

together with Warady's teachings of

"the … […] … <u>system</u> … […] … generates … […] … enrollment form <u>for each employee described in the employee data files 20 and eligible</u> to receive one or more benefits … […] … according to the data and instructions entered into the benefit files 10, the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are <u>individualized</u> for each employee to include, for example, <u>all benefit plans and coverage options that are available to be selected by the employee</u> as well as prices and credits (if any) associated with each benefit plan and coverage option … […] … the information included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer" (emphasis added) (Warady column 9, line 58 to column 10, line 8),

to teach a form of these limitations.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method of Lockwood to include these limitations, as taught by Warady, with the motivations of enabling enrollment forms that are customized for each employee on an individual basis, providing a system that manages health and welfare benefit enrollment information, that can communicate the information to interested parties such as, for example, participating employees and plan providers, and produce the billings needed for each plan provider's premiums and/or fees, and reduce time wasted and human error by employers and employees implementing and administering health and welfare benefit plans (Warady, column 1, lines 44-45, 57-61, column 2, lines 35-45).

Lockwood fails to explicitly disclose wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal.

However, the above features are well-known in the art, as evidenced by Tyler.

In particular, Tyler teaches

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined teachings of Lockwood and Warady to include these

limitations, as taught by Tyler, with the motivations of "design[ing] an insurance product for a

customer … [...] … receiving a request for information about an insurance product or policy …

[...] … accessing stored information, such as rates, performing the necessary calculations based

on the request and returning the requested information to the user" (Tyler; column 5, lines 32-38)

and providing a "uniform approach … [...] … in which one user interface can be used to enter

information about all possible products, and where the calculations that are performed are

designed based on the operations that take place" (Tyler, column 4, lines 56-62).

   (B)   As per claims 2-5, Lockwood, Warady, and Tyler teach a method as analyzed and

discussed in claim 1 above:

   further comprising a step of printing the customized proposal (Lockwood; column 7,

lines 5-24);

   wherein the generating step comprises providing insurance company data as part of the

customized proposal (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column

2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24,

column 7, line 60 to column 8, line 2, column 9, lines 13-30);

   further comprising a step of providing the customized proposal in electronic form to the

customer (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60,

column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line

60 to column 8, line 2, column 9, lines 13-30); and

   wherein the generating step comprises deriving the estimated costs from information

sorted in the database (Lockwood; column 3, lines 9-48, column 6, lines 17-32).

(C)   As per claims 6-8, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above:

further comprising a step of obtaining the user selected plan options from the input device of the computer system (Lockwood; column 3, lines 17-25, column 6, lines 3-4);

wherein the indication that a plan has been determined to not be currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan (Warady; column 4, line 51 to column 5, line 5, column 5, line 65 to column 6, line 7); Examiner interprets Warady's teachings of " … [...] ... prerequisites table 110 stores information describing which benefit plans, if any, described in the benefit tables 100 have prerequisites that must be met before an employee can be enrolled in the plans. For example, certain life insurance plans require evidence of insurability of an employee to be approved by the plan provider before the employee is eligible to receive the chosen benefit or level of coverage. In this example, the prerequisites table 110 could store information describing the conditions under which evidence of insurability is required by the plan provider … [...] ... " (Warady; column 5, line 65 to column 6, line 7) to teach a form of "wherein the indication that a plan has been determined to not be currently available to the customer comprises conditions which are not met for the customer to qualify for the offered but currently not available insurance plan;"

wherein the presenting step comprises:

selecting, with the input device (Lockwood; column 6, lines 3-4) one or more sets of possible insurance plans from the insurance plan options presented to the customer on the display device (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

determining an estimated cost for each of the selected sets of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30); and

generating a customized comparison for the possible set of insurance plans in the sales computer system that includes the customer data, the description of the selected insurance plans, and the estimated costs for the selected set of insurance plans (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(D)   As per claims 9-10, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the available insurance plan options comprise a plurality of health insurance plans (Lockwood; column 3, lines 32-36);

further comprising a step of transmitting the customer data and the user selected plan options from the computer system to a remote server system for processing of a request for insurance (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30).

(E)   Claim 11 differs from method claim 1 by reciting a "computer program product readable by a computer system ... " in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system ... (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 11 substantially repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(F)   As per claims 20-23, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the generating step comprises providing an insurance plan as part of the customized proposal (Lockwood; column 3, lines 9-48, column 6, lines 17-32);

wherein the generating step comprises gathering "predetermined customer information" (reads on providing insurance application forms") as part of the customized proposal (Lockwood; column 3, lines 15-16);

wherein the generating step comprises providing "a series of quotations from various institutions... purchaser can compare quotations" (reads on "benefit charts data") as part of the customized proposal. (Lockwood; column 3, lines 32-33); and

wherein the generating step comprises providing provider information data as part of the customized proposal (Lockwood; column 7, lines 5-12).

(G)   As per claims 24-27, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above, wherein the available insurance plan options comprise

a plurality of dental insurance plans (Warady; column 4, lines 1-19);

a plurality of life insurance plans (Warady; column 4, lines 1-19);

a plurality of disability insurance plans (Warady; column 4, lines 1-19); and

wherein the insurance plan comprises a set of insurance plans (Warady; column 4, lines 1-19).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(H)   As per claims 28-29, Lockwood, Warady, and Tyler teach a method as analyzed and discussed in claim 1 above

wherein the storing step comprising storing the customer data and insurance plan

products in a relational database (Tyler; Figure 6C, column 22, lines 37-38) that is hosted in a

networked environment (Lockwood; column 2, lines 34-46) with portions stored in a remote

memory storage device (Lockwood; column 2, lines 51-54);

wherein the storing step comprising storing the customer data and insurance plan

products in a relational database (Tyler; Figure 6C, column 22, lines 37-38) comprising a

plurality of modules (Warady; Figure 1, column 8, lines 20-35).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler

are as given in the rejection of claim 1 above, and incorporated herein.

(I)   Claim 30 differs from method claim 1, in that it is a system rather than a method

for generating a customized proposal in the development of insurance plans for a customer.

System claims 30-47 repeat the subject matter of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10,

and 27 respectively, as a set of elements rather than a series of steps. As the underlying

processes of claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27 have been shown to be fully disclosed

or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of

claims 1-3, 20-23, 4-7, 8-9, 24-26, 10, and 27, it is readily apparent that the system disclosed

collectively by Lockwood, Warady, and Tyler includes the apparatus to perform these functions.

As such, these limitations are rejected for the same reasons given above for method claims 1-3,

20-23, 4-7, 8-9, 24-26, 10, and 27, and incorporated herein. As per the recitation in claim 39 of

"the input device processor unit is configured to prompt the user to input selected plan options,"

Examiner interprets Lockwood's teachings of "[t]he presentation solicits and allows the

customer to enter information at various points via the touch pad 13 displayed on the monitor screen" (Lockwood; column 5, lines 7-9, column 6, lines 2-13) to teach a form of this limitation.

(J)   Claims 48-49 differ from method claims 28-29 in that they recite a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claims 48-49 repeat the subject matter of claims 28-29 respectively, as a set of elements rather than a series of steps. As the underlying processes of claims 28-29 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of claims 28-29, it is readily apparent that the system disclosed collectively by Lockwood, Warady, and Tyler includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claims 28-29, and incorporated herein.

(K)   As per newly amended claim 50, Lockwood, Warady, and Tyler teach a method for generating a customized proposal in the development of insurance plans for a customer (Lockwood; column 3, lines 32-44, column 6, lines 3-11), the method comprising:

storing customer data within a database in a computer system (Lockwood; Abstract, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 37 to column 6, line 32, column 7, lines 5-24, column 7, line 43 to column 8, line 15, column 9, lines 13-30) by using one or more modules (Lockwood; Abstract, column 2, lines 48-55); (Examiner interprets Lockwood's teachings of "programmed to gather a predetermined sequence of information from

a customer on the services in which the customer is interested … [...] … transmit the information

to the central data processing center … [...] … extracts the desired information from its storage

… [...] … transmits it back to the terminal … [...] … relayed to the customer" (Lockwood;

column 2, lines 48-55) to teach a form of using one or more software modules), the database

having stored therein insurance plan products with plan requirements data (Lockwood; column 5,

lines 37-48); Examiner interprets Lockwood's teaching of "[t]he memory 23 stores program

information and information on insurance policies and prices for various insurance companies,

which are periodically up-dated from the terminals 4 of the various companies, and information

on policy quotes and sales, which can be accessed periodically by the respective insurance

company terminals ... [   ] ... to perform insurance quotation calculations in response to customer

information received from any of the terminals, to send quotation data to the respective terminal"

(Lockwood; column 5, lines 37-48) to necessarily include storing in the "memory" (reads on

"database") plan requirements data in order to produce the insurance quotation;

     comparing the customer data with the plan requirements data from the stored insurance

plan products by using the one or more modules (Warady; column 5, line 65 to column 6, line

23, column 8, lines 20-46, column 10, lines 55-67); Examiner interprets Warady's teaching of

"… [...] … system 1 generates a confirmation of each employee's enrollment status … [...] … "

(Warady; column 10, lines 55-57) to teach a form of "comparing the customer data with the plan

requirements data from the stored insurance plan products by using the one or more modules;"

     determining if a particular insurance plan may be offered but is not currently available to

the customer based upon the stored plan requirements data and either the stored customer data or

user selected plan options by using the one or more modules (Warady Figure 1, column 4, line

51 to column 5, line 5, column 5, line 65 to column 6, line 7, column 8, lines 20-35, column 9,

line 58 to column 10, line 8); the user selected plan options being obtained from an input device

of the computer system (Warady; column 13, lines 50-53);

      presenting a description of insurance plan options available to the customer on a

"terminal" (reads on "display device of the computer system") (Lockwood; column 3, lines 9-48,

column 6, lines 5-11) based upon the stored customer data and the user selected plan options by

using the one or more modules (Lockwood; Abstract, column 2, lines 48-55) (Examiner

interprets Lockwood's teachings of "programmed to gather a predetermined sequence of

information from a customer on the services in which the customer is interested … [...] ...

transmit the information to the central data processing center … [...] ... extracts the desired

information from its storage … [...] ... transmits it back to the terminal … [...] ... relayed to the

customer" (Lockwood; column 2, lines 48-55) to teach a form of "presenting a description of

insurance plan options currently available to the customer … [...] ... by using the one or more

modules"), the description of insurance plan options including an indication that a particular

insurance plan had previously been unavailable to the customer (Warady; column 4, line 51 to

column 5, line 30, column 5, line 55 to column 6, line 11, column 9, line 58 to column 10, line

8); Examiner interprets Warady's teachings of

          "tables of information that describe the employer … [...] ... , the employer's health
      and welfare benefit policies, the <u>benefit plans</u> in which the employer's employees can be
      enrolled … [...] ... information can include, for example, the benefit types and coverage
      options available to the employees for enrollment selection, identification of which

benefits are employee selectable and which are attached to other employee selections
[reads on "indication that a particular insurance plan had previously been unavailable to
the customer" as it is tied to <u>other</u> employee selections]… […] … , identification of
[particular] plan features that generate cost or premium billings based on other employee
selections but are <u>not</u> benefits disclosed to or payable to employees (e.g., stop loss
insurance which protects the employer against excessive claims under self-insured plans)
… […] …   It should be appreciated that additional or different information can be
included in the benefit files as needed to accommodate different types of benefit plans or
employer policies," (emphasis added) (Warady; column 4, line 51 to column 5, line 5);

and Warady's teachings of

" … […] … prerequisites table 110 stores information describing which benefit
plans, if any, described in the benefit tables 100 have prerequisites that must be met
before an employee can be enrolled in the plans. For example, certain life insurance
plans require evidence of insurability of an employee to be approved by the plan provider
before [i.e. not currently available] the employee is eligible to receive the chosen benefit
or level of coverage. In this example, the prerequisites table 110 could store information
describing the conditions under which evidence of insurability is required by the plan
provider … […] … " (Warady; column 5, line 65 to column 6, line 7),

together with Warady's teachings of

"the … […] … <u>system</u> … […] … generates … […] … enrollment form <u>for each
employee described in the employee data files 20 and eligible</u> to receive one or more
benefits … […] … according to the data and instructions entered into the benefit files 10,
the employee data files 20, the sponsor file 30, and the code file 40 in step S1 and are
<u>individualized</u> for each employee to include, for example, <u>all benefit plans and coverage
options that are available to be selected by the employee</u> as well as prices and credits (if
any) associated with each benefit plan and coverage option … […] … the information

included in each enrollment form can be based, for example, on relevant characteristics of the employee, such as job classification, division, work location, age and salary, and rules established by the employer" (emphasis added) (Warady column 9, line 58 to column 10, line 8),

to teach a form of "the description of insurance plan options including an indication that a particular insurance plan had previously been unavailable to the customer;" and

generating a customized proposal in the computer system that is "extracted" from stored information (reads on "different from the stored insurance products") (Lockwood; column 2, lines 47-60) by the comparing the customer data and the determining of the particular insurance plan, based upon a selection made from the presented insurance plan options that includes a description of an insurance plan by using the one or more modules (Lockwood; column 2, lines 48-55), at least a portion of the customer data, and estimated costs for the insurance plan (Lockwood; Abstract, column 1, lines 20-36, column 1, line 45 to column 2, line 60, column 3, lines 9-48, column 5, line 65 to column 6, line 32, column 7, lines 5-24, column 7, line 60 to column 8, line 2, column 9, lines 13-30);

wherein the customized proposal resulted from a preliminary proposal module taking a plan produced by a plan configuration engine module along with cost data to produce a formal proposal (Tyler; Abstract, column 4, line 65 to column 5, line 40, column 6, lines 58-65).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(L)   Claim 51 differs from method claim 50 by reciting a "computer program product readable by a computer system … " in the preamble. As per this limitation, Lockwood clearly discloses his invention to be implemented on a computer program product readable by a computer system … (Lockwood; Figure 1, column 2, lines 8-18, 34-46). The remainder of claim 51 repeats the limitations of claim 50, and is therefore rejected for the same reasons given above for claim 50.

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler are as given in the rejection of claim 1 above, and incorporated herein.

(M)   Claim 52 differs from method claim 50, in that it is a system rather than a method for generating a customized proposal in the development of insurance plans for a customer.

System claim 52 repeats the subject matter of claim 50, respectively, as a set of elements rather than a series of steps. As the underlying processes of claim 50 have been shown to be fully disclosed or obvious by the collective teachings of Lockwood, Warady, and Tyler in the above rejection of claim 50, it is readily apparent that the system disclosed collectively by Lockwood, Warady, and Tyler includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 50, and incorporated herein. . As per the recitation in claim 52 of "an input device configured to prompt a user of the computer system to input customer data … [...] … ," Examiner interprets Lockwood's teachings of "[t]he presentation solicits and allows the customer to enter information at various points via

the touch pad 13 displayed on the monitor screen" (Lockwood; column 5, lines 7-9, column 6,

lines 2-13) to teach a form of this limitation.

(N)   As per newly added claims 53-54, Lockwood, Warady, and Tyler teach a method

as analyzed and discussed in claim 1 above further comprising:

tracking the status of proposals (Lockwood; column 5, lines 36-55, column 6, lines 7-9,

column 7, line 60 to column 8, line 2);

storing and printing sales collateral material and forms (Lockwood; Abstract, column 1,

lines 45-55, column 6, lines 10-11); and

"dispensing information and contractual services to the general public" (reads on

"providing a product discovery consultation function" (Lockwood; column 1, lines 23-36);

wherein the computer system that is used in the storing of the customer data, is a

component based, object-oriented design that is distributed across a multi-tier architecture, the

multi-tier architecture comprising a standard networking communications interface (reads on "an

application layer, a presentation layer, a session layer and a data layer") (Tyler; Figure 1B,

column 5, lines 32-40, column 6, lines 10-13, 46-57, column 9, lines 19-35, column 10, line 48

to column 11, line 31).

The motivations for combining the respective teachings of Lockwood, Warady, and Tyler

are as given in the rejection of claim 1 above, and incorporated herein.

Response to Arguments

11.   Applicant's arguments filed 24 February 2009 have been fully considered but they are

not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they

appear in the response filed 24 February 2009.

    (A)   At pages 15-17 of the 24 February 2009 response Applicant argues the rejections

of claims 1, 50-52 under 35 U.S.C. 112, second paragraph, for being indefinite. Applicant has

amended these claims, thus clarifying the claims, and accordingly this rejection has been

withdrawn.

    (B)   At pages 17-19 of the 24 February 2009 response Applicant argues that the

features in the Application are not taught or suggested by the applied references. In response, all

of the limitations which Applicant disputes as missing in the applied references, including the

newly added limitations of the amendment filed 24 February 2009, have been fully addressed by

the Examiner as being obvious in view of the combined teachings of Lockwood, Warady and

Tyler, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the

time of the invention, as detailed in the remarks and explanations given in the preceding sections

of the present Office Action and in the prior Office Action (paper number 20080709), and

incorporated herein. In particular, Examiner notes that the recited features of "generating a

customized proposal in the computer system based upon a selection made from the presented

insurance plan options that includes a description of an insurance plan … [...] … wherein the

customized proposal resulted from a preliminary proposal module   … [...] … to produce a formal

proposal" as recited in claims 1, 11, 30 and 50-52, are taught by the combination of applied

references (see Lockwood; column 3, lines 9-48, column 6, lines 1-65, column 7, lines 5-51) and

(Tyler; column 5, lines 32-40, column 6, lines 58-65); Examiner interprets Lockwood's

teachings of "[o]n receipt of the [preliminary proposal] quotation (47), the customer is asked if

he/she wants a printed copy (48). If the customer answers yes, a printout is made at printer unit

20 (49). The customer is then asked if he/she wishes to purchase an insurance policy (50) … [...]

… If the answer is yes, the customer is asked to select the insurance coverage and insurance

company desired (53) … [...] … The policy information collected at steps 53 and 62 is

transmitted to the central data processing center. A [formal proposal] binder policy issuance

sequence is initiated at the center, as described in connection with FIG. 6 below. The binder

policy information is then sent from the central data processing center back to the terminal,

where the policy is printed out (63)" (Lockwood; column 7, lines 14-51) together with Tyler's

teachings of "design an insurance product for a customer" (Tyler; column 5, lines 32-40) and

"calculation engine performs all required calculations related to the proposal based on the

information entered … [...] … and returns the proposal output to the user" (Tyler; column 6,

lines 58-65) to teach a form of the recited limitation.

As per Applicant's assertion in paragraph 3, page 18 of the 24 February 2009 response

that the Tyler reference fails to teach limitations recited in claims 1, 11, 30 and 50-52, Examiner

respectfully notes that it is the combination of applied references, and not the Tyler reference

alone, that teach these limitations, as is discussed earlier in this Office Action.

As per Applicant's argument in page 18, lines 15-16 of the 24 February 2009 response

that the Tyler reference "does not prepare a formal proposal that had previously been unavailable

to the customer," Examiner respectfully notes that this is not a claimed limitation.

Conclusion

12.   The prior art made of record and not relied upon is considered pertinent to Applicant's

disclosure. The cited but not applied references Greulich et al., U.S. Patent Number 5241464,

Johnson et al., U.S. Patent Number 5615342, Johnson et al., U.S. Patent Number 5625776,

Johnson et al., U.S. Patent Number 5758331, Mathews, U.S. Patent Number 6041303,

Johnson et al., U.S. Patent Number 6169979, Johnson et al., U.S. Patent Number 7519549, and

Johnson (WO 93/22739) teach the environment of electronically configuring and processing of

proposals.

13.   Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: **(571) 273-8300**.

For informal or draft communications, please label "PROPOSED" or "DRAFT"

on the front page of the communication and do NOT sign the communication.

After Final communications should be labeled "Box AF."

14.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

15.   If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

16.   Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
May 9, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686